

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, tentatively rejected all claims 1-7. Specifically, the Office Action rejected claims 1-7 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. patent 6,494,663 to Ostwald in view of U.S. patent 6,280,134 to Nering. Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

All of these amendments are made to bring the claims into allowance.

Claim Amendments

Claims 1-3, 5 and 6 are canceled. Claim 4 is amended by adding the limitations of “a stocker, comprising a body, a plurality of cells, an in/out port (I/O port) and a transport device, wherein the cells and the in/out port (I/O port) are disposed in the body, and the transport device transports the goods between the cells and the I/O port” and “wherein the transport device directly removes the goods from the overhead shuttle or directly places the goods into the overhead shuttle when the overhead shuttle travels to the I/O port”. The added limitations are recited in original claims 1 and 6. Thus, the amendment adds no new matter to the application.

35 U.S.C. §103

Claim 4 is amended by adding limitations of “a stocker, comprising a body, a plurality of cells, an in/out port (I/O port) and a transport device, wherein the cells and the in/out port (I/O port) are disposed in the body, and the transport device transports the goods between the cells and the I/O port” and “wherein the transport device directly removes the goods from the

overhead shuttle or directly places the goods into the overhead shuttle when the overhead shuttle travels to the I/O port". Neither Ostwald nor Nering teach the claimed feature of "**a transport device directly removes the goods from the overhead shuttle or directly places the goods into the overhead shuttle, and transports the goods between the cells and the I/O port**".

In a conventional stocker utilizing overhead shuttle, additional robot or rollers are required to move goods to a transport device, and the transport device moves the goods to cells. The automatic material handling system of the claimed embodiments allow a transport device to directly remove the goods from the overhead shuttle or to directly place the goods into the overhead shuttle, and transport the goods between the cells and the I/O port. This operation is not disclosed in either Ostwald or Nering.

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art.

See, e.g., In re Dow Chemical, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Thus, as amended claim 4 is patently defines over the cited art for at least this reason. Claim 7, which depends from claim 4, patently defines over the cited art for at least the same reason.

As a separate and independent basis for the patentability of claims 4 and 7, Applicants respectfully traverse the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious "in order to allow the device to move objects to various process devices without interfering with a person who may be working in the area of as the transport

takes place in an elevated area of the facility.” (Office Action, page 3). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. . . ." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an automatic material handling system, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir.

1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:



Daniel R. McClure
Registration No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500